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EXAMINER
HANNAHER, CONSTANTINE

ART UNIT	PAPER NUMBER
2878	

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/819,074	ROSS ET AL.
	Examiner	Art Unit
	Constantine Hannaher	2878

-- The MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 June 2001 and 05 October 2001* .

2a)☐ This action is FINAL. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3,4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. It is considered that the claims encompass more than one distinct species, but no requirement for election is made at this time.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

> An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

Information Disclosure Statement

3. Where the IDS citations are submitted but not described, the examiner is only responsible for cursorily reviewing the references. The initials of the examiner on the PTO-1449 indicate only that degree of review unless the reference is either applied against the claims, or discussed by the examiner as pertinent art of interest, in a subsequent office action. See Guidelines for Reexamination of Cases in View of *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), 64 FR at 15347, 1223 Off. Gaz. Pat. Office at 125 (response to comment 6). Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above. MPEP § 609 (Eighth Edition, August 2001).

4. As set forth in MPEP § 609:

> 37 CFR 1.98(b) requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent, the applicant should list the patent in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

5. The examiner has considered information considered by the Office in a parent application when examining this continuing application, and the application file reflects that fact. A list of the information need not be submitted in the continuing application unless applicant desires the information to be printed on the patent. MPEP § 609.

Therefore, although the United States Patent to Sommer, Jr. *et al.* (US005260576A) has been considered in accordance with the paragraph above, evidence thereof must be denied because the patent has not been identified by its issue date.

6. The errors in the information disclosure statement cannot be considered a matter of inadvertence in view of the presence of the INID codes on the document(s), see MPEP § 901.05(b). Applicant has already received this caution. See the first paragraph of the Office action in parent application 09/187,579 mailed September 21, 2000. Accordingly, evidence of consideration of the French patent must be denied.

Oath/Declaration

7. When applicant states that the post office address is the "same" as residence applicant's representative should keep in mind that a "residence" is a city and state or foreign country. The superfluous information given for residence is accepted as constituting a mailing address. The Office has been able to discern the city and state or foreign country of residence from the information supplied. See the requirements of 37 CFR 1.63(c)(1) as amended effective November 7, 2000.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in-
>
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claims 1, 2, 4, 10, 11, 12, 15, 17, 19, 20, and 22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Duggan *et al.* (US006124594A).

With respect to independent claim 1, Duggan *et al.* discloses an apparatus (Fig. **2**) for detecting the presence of an ophthalmic product in a container, comprising a source **12** of electromagnetic energy located relative to the container **1** to direct electromagnetic energy at the container, a detector **13** disposed relative to the container **1** and the source **12** to detect electromagnetic energy from the source which interacts with the product and container in one or more of the recited ways, and means **15** for indicating the presence of the product in the container **1**

responsive to one or more of the recited interactions of electromagnetic energy by the product (column 2, lines 28-30).

With respect to dependent claim 2, the product in the apparatus of Duggan *et al.* is a contact lens (column 1, line 7).

With respect to dependent claim 4, the source **12** in the apparatus of Duggan *et al.* emits electromagnetic energy having a wavelength in the infrared range (column 1, line 67).

With respect to dependent claim 10, the contact lens in the apparatus of Duggan *et al.* includes a media (at least one monomer having (meth)acrylate functionality) which interacts with electromagnetic radiation of a wavelength in a specified range in one or more of the recited ways, and the container **1** includes a receptacle **2** for the lens and is constructed from a material which interacts with the electromagnetic energy in one or more of the recited ways differently than does the lens (column 2, lines 16-19).

With respect to dependent claim 11, the contact lens in the apparatus of Duggan *et al.* includes a media (at least one monomer having (meth)acrylate functionality) which interacts with electromagnetic radiation having a wavelength in a specified range in one or more of the recited ways, and the detector **13** is sensitive to electromagnetic energy in the specified range (infrared, column 1, line 67 to column 2, line 1).

With respect to dependent claim 12, the apparatus of Duggan *et al.* further comprises a plurality of sources **12** and a plurality of detectors **13** disposed relative to each other for detecting the presence of a contact lens in a container **1** (column 2, lines 63-67).

With respect to dependent claim 15, the detector **13** in the apparatus of Duggan *et al.* is a spectrometer (column 2, lines 23-27).

With respect to independent claim 17, Duggan *et al.* discloses a method corresponding to the illustrated apparatus (Fig. **2**) for detecting the presence of an ophthalmic product in a container, the product including a media (at least one monomer having (meth)acrylate functionality) which interacts with electromagnetic energy of a frequency in a specified range (column 2, line 16) in one or more of the recited ways, comprising the steps of directing electromagnetic energy (from a source **12**) of a frequency in the specified range (column 2, lines 20-21) at the product and container **1**, detecting (with a detector **13**) electromagnetic energy which interacts with the product and container in one or more of the recited ways, and processing (with means **15**) the detected electromagnetic energy to determine the presence of the product in the container **1**.

With respect to dependent claim 19, the electromagnetic radiation in the method of Duggan *et al.* is in the infrared range (column 1, line 33).

With respect to independent claim 20, Duggan *et al.* discloses a method corresponding to the illustrated apparatus (Fig. **2**) for detecting the presence of an ophthalmic product in a container, the product including a media (at least one monomer having (meth)acrylate functionality) which interacts with electromagnetic energy of a frequency in a specified range (column 2, line 16) in one or more of the recited ways, comprising the steps of directing electromagnetic energy (from a source **12**) at the product and container **1**, detecting (with a detector **13**) the absence of or reduction in electromagnetic energy of a frequency in a specified range which interacts with the product and container in one or more of the recited ways (column 2, lines 28-30), and processing (with means **15**) the detected electromagnetic energy to determine the presence of the product in the container **1**.

With respect to dependent claim 22, the electromagnetic radiation in the method of Duggan *et al.* is in the infrared range (column 1, line 33).

10. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ebel *et al.* (US005640464A).

With respect to independent claim 1, Ebel *et al.* discloses an apparatus **10** (Fig. **1**) for detecting the presence of an ophthalmic product **76** in a container **66** (Fig. **2**) comprising a source **36** of electromagnetic energy located relative to the container to direct electromagnetic energy **80** (Fig. **5**) at the container, a detector **42** disposed relative to the container **66** and the source **36** to detect electromagnetic energy from the source which passes through the product **76** and the container **66**, and means **20** for indicating the presence of the product **76** in the container **66** (column 3, lines 18-21) responsive to absorption of the electromagnetic energy by the product (column 5, lines 34-40).

With respect to dependent claim 2, the product **76** in the apparatus of Ebel *et al.* is a contact lens (column 1, line 9).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made

in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 5-7, 9, 13, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duggan *et al.* (US006124594A).

With respect to dependent claims 5-7 and 9, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the apparatus of Duggan *et al.* is indifferent to the composition of the contact lens as long as it has organic molecules containing "interatomic valence bonds which exhibit characteristic resonance frequencies in the IR range" (column 2, lines 9-12). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the recitation of the apparatus of Duncan *et al.* to encompass all contact lenses having this kind of organic molecule. The recited contact lenses of claims 5-7 and 9 are considered to have at least one such molecule.

With respect to dependent claim 13, the exact nature of the detector **13** in the apparatus of Duggan *et al.* is not specified. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Duggan *et al.* to specify any detector capable of detecting electromagnetic energy of the type emitted by source **12** and having interacted with the product in the container **1**. A calorimeter is known as a detector of infrared energy as emitted by source **12** and having interacted with the product in the container.

With respect to dependent claims 14 and 16, the presence of a filter would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the opportunity to reduce the detection of wavelengths other than the useful one identified (column 2, line 27).

14. Claims 1-3, 5-11, 13-18, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins *et al.* (US005633504A).

With respect to independent claim 1, Collins *et al.* discloses an apparatus (Fig. **1**) comprising a source **12** of electromagnetic energy located relative to a container **16** to direct electromagnetic energy thereat, a detector **22** disposed relative to the container **16** and the source **12** to detect electromagnetic energy from the source which passes through or is reflected by an ophthalmic product **20** and the container **16**, and means (a video monitor, column 3, lines 3-4) for indicating the presence or position of the product **20** in the container **16** responsive to one of the fluorescence, absorption, or reflection of the electromagnetic energy by the product **20**. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the described video monitor afforded detection of the presence or position of the ophthalmic product **20** in the container **16**.

With respect to dependent claim 2, the product 20 in the apparatus of Collins *et al.* is a contact lens (column 2, line 11).

With respect to dependent claim 3, the source **12** in the apparatus of Collins *et al.* may emit in the ultraviolet range (column 2, lines 47-52).

With respect to dependent claim 5, the contact lens **20** in the apparatus of Collins *et al.* may contain an ultraviolet absorbing media (column 4, lines 30-63).

With respect to dependent claims 6 and 7, the utility of the ultraviolet absorbing media contained in the contact lens **20** in the apparatus of Collins *et al.* is a choice within the ordinary skill in the art in view of the desired performance.

With respect to dependent claim 8, the source **12** in the apparatus of Collins *et al.* may emit in the visible range (column 2, lines 52-55) and the contact lens **20** contains a tint based on its dark

appearance (column 2, line 41) with respect to transmission of the visible fluoresence created in the embodiment in which the container **16** is made to fluoresce.

With respect to dependent claim 9, the lens **20** in the apparatus is considered to be a hygroscopic lens in view of the hydration suggested (column 3, lines 62-64).

With respect to dependent claim 10, the embodiment described by Collins *et al.* at column 2, lines 36-43 includes a lens **20** and a container **16** serving as a receptacle that differ in their absorption or reflection of electromagnetic energy in the visible range.

With respect to dependent claim 11, the embodiment described by Collins *et al.* at column 2, lines 36-43 includes a lens **20** which absorbs electromagnetic energy (the fluorescence of the container **16**) to which the detector **22** is sensitive.

With respect to dependent claim 13, the detector **22** in the apparatus of Collins *et al.* is a video camera (column 2, line 63). The use of any particular type of detector is a choice within the ordinary skill in the art in view of the desired performance.

With respect to dependent claim 14, a filter is described by Collins *et al.* at column 2, lines 55-62.

With respect to dependent claim 15, the detector **22** in the apparatus of Collins *et al.* is a video camera (column 2, line 63). The use of any particular type of detector is a choice within the ordinary skill in the art in view of the desired performance.

With respect to dependent claim 16, a filter is described by Collins *et al.* at column 2, lines 55-62.

With respect to independent claim 17, Collins *et al.* suggests a method corresponding to the disclosed apparatus (Fig. **1**) which would comprise the steps of directing electromagnetic energy (using source **12**) at an ophthalmic product **20** and container **16**, detecting (using detector **22**)

electromagnetic energy from the source which passes through or is reflected by the product **20** and the container **16**, and processing (using a video monitor, column 3, lines 3-4) the detected electromagnetic energy to determine the presence or position of the product **20** in the container **16**. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the described video monitor afforded detection of the presence or position of the ophthalmic product **20** in the container **16**.

With respect to dependent claim 18, the source **12** used in the method of Collins *et al.* may emit in the ultraviolet range (column 2, lines 47-52).

With respect to independent claim 20, Collins *et al.* suggests a method corresponding to the disclosed apparatus (Fig. **1**) which would comprise the steps of directing electromagnetic energy (using source **12**) at an ophthalmic product **20** and container **16**, detecting (using detector **22**) the absence of or reduction in electromagnetic energy of a frequency in a specified range (such as the fluorescence in the container **16** described at column 2, lines 36-43) which passes through or is reflected by the product **20** and the container **16**, and processing (using a video monitor, column 3, lines 3-4) the detected electromagnetic energy to determine the presence or position of the product **20** in the container **16**. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the described video monitor afforded detection of the presence or position of the ophthalmic product **20** in the container **16**.

With respect to dependent claim 21, the source **12** used in the method of Collins *et al.* for the electromagnetic energy of step (a) may emit in the ultraviolet range (column 2, lines 47-52). The electromagnetic energy of step (b) has no necessary relation thereto.

15. Claims 8, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebel *et al.* (US005640464A).

With respect to dependent claim 8, the source **36** in the apparatus of Ebel *et al.* emits electromagnetic energy in the visible range (column 4, line 28). The utility of the apparatus **10** when the contact lens **76** contained a tint would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the recognition of light attenuation at column 5, lines 34-40.

With respect to dependent claim 9, one of ordinary skill in the art would have found it obvious to recognize that the contact lens **76** detected by the apparatus of Ebel *et al.* was hygroscopic as this is a typical item of manufacture.

With respect to dependent claim 12, the apparatus of Ebel *et al.* further comprises a plurality of detectors **42** disposed therein (Fig. **1**). Although Ebel *et al.* describes a single source **36**, one of ordinary skill in the art at the time the invention was made would have found it obvious to modify the apparatus **10** to further comprise a plurality of sources disposed therein in view of the flexibility this affords in installing the apparatus in a production line, for example, should there be a return belt of the conveyor.

Response to Submission(s)

16. A statutory double patenting rejection under 35 U.S.C. 101 of the type contemplated in the decision on petition mailed October 12, 2001 cannot be made because the copy of the specification (including the claims) submitted on October 5, 2001 with the petition is not a copy of the specification (including the claims) of the application as it was before the request for a Continued Prosecution Application but rather a copy of the application as originally filed November 5, 1998.

17. Since the document WO00/16072 is not available to the Examiner under any section of 35 U.S.C. 102, the applicable prior art rejections based on the information cited in the IDS contemplated in the decision on petition mailed October 12, 2001 cannot be made. The United

States Patent applied, Duggan *et al.* (US006124594A), matured from the priority application to the international filing.

18. If necessary, Hung *et al.* (US005399692A or US005500024A) can be applied in combination against at least claim 5 in view of the C=O bond in the ultraviolet absorbing media disclosed therein as suitable for the manufacture of contact lenses of the type examined in the apparatus of Duggan *et al.*

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (703) 308-4850. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on (703) 308-4881. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

ch
May 21, 2002

Constantine Hannaher
Primary Examiner